



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/402,674	10/08/1999	JARI KOISTINEN	365-428PCT	6270

7590 11/14/2002
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 220400747

EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
----------	--------------

1751

DATE MAILED: 11/14/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

WZ

Office Action Summary

Applicati n No.

09/402,674

Applicant(s)

KOISTINEN ET AL.

Examiner

Margaret Einsmann

Art Unit

1751

-- The MAILING DATE of this communication appears on the cov r sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002 .
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 17, 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/3/2002 has been entered.

Applicant's amendment received September 3, 2002 has been entered and applicant's remarks considered. The pending claims are claims 7, 19-26.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahara et al. Nakahara et al. disclose compositions comprising lubricating oils

synthesized from esters combined with various polyols and linear and branched mono- and di- carboxylic acids, said oils mixed with fluorocarbon refrigerants. The glycols and carboxylic acids used are listed in columns 3 and 4 and include nearly all claimed. See also col 1 line 46 to col 2 line 48. Regarding the claims 17, 19-26, esters of all of the claimed polyols are disclosed in col 4, the individual mono- and di- carboxylic acids are listed in columns 3 and 4. Patentee claims and even exemplifies the formation of mixed esters. See example 10 where HPHP (hydroxypivalic acid neopentyl glycol monoester) is combined with neopentyl glycol, succinic acid and 2-ethylhexanoic acid, which is the in situ process as claimed. Note that the HPHP is mixed in a proportion such that it is at least 50% of the polyol residue of the ester mixture as claimed. The two acids, a dibasic and a monobasic, both fall within the scope of those instantly claimed. The example differs from the instant claims because the glycol used in this example is not one of the glycols instantly claimed.

It would have been obvious to the skilled artisan to substitute one of the claimed polyols for neopentyl glycol in the process of Nakahara's claim 10 with the expectation of equivalent results because patentee teaches the equivalence of all of the claimed polyols, (trimethylol propane, trimethylolethane, pentaerythritol and 2,2,4-trimethylpentadiol) to the neopentyl glycol used in example 10. See col 4 lines 26 et seq. Note particularly lines 35-36 where both neopentyl glycol and the claimed trimethylol propane are preferred.

Response to arguments

Applicant argues the rejection of the claims as being obvious by stating

1. There are different methods of forming HPHP and that applicant uses a pure commercial product while the product of patentee's example 1 process needs post treatment and purification. Applicant states that the preparation of HPHP from HP acid and neopentyl glycol yields an inferior product. In response to this argument, the HPHP of example 10 uses the product of example 1, which is formed from hydroxypivaldehyde. See example 1. Patentee states in example that he is using hydroxypivalic acid neopentylglycol monoester. That is the same chemical as the claimed HPHP. Additionally, applicant's arguments may not be substituted for evidence in the form of a declaration.

2. Applicant next refers to examples 7 and 9 in Table 4. Those examples cannot be used to argue limitations in the instant claims as they are directed to compositions which are not claimed. Applicant argues that the solubility is unpredictable. That is even more so when esters from different polyols and acids are used.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Application/Control Number: 09/402,674

Page 5

Art Unit: 1751

A handwritten signature in cursive script, reading "Margaret Einsmann".

MARGARET EINSMANN

PRIMARY EXAMINER 1751

11/8/02